

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

patent
appln. of: Frank D'Aguanno
Serial No.: 09/676,627
Filed: October 2, 2000
For: METHOD AND APPARATUS
FOR REMOVING A GOLF
CLUB HEAD FROM A
GOLF CLUB SHAFT
Examiner: Daniel G. Shanley
Grp. Art Unit: 3723
Atty. Dkt.: 18781.00201

**CERTIFICATE OF FACSIMILE TRANSMISSION
AND MAILING UNDER 37 C.F.R. 1.8**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being facsimile transmitted to (703) 746-3280 and deposited with the United States Postal Service, First Class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, Washington, DC 20231 on the date indicated below to the Patent and Trademark Office.

BY: FLORIDA BRYANT

Signature

DATE: 30 SEPTEMBER 2002

Commissioner for Patents
Washington, D.C. 20231

AMENDMENT**RECEIVED**

OCT 10 2002

TECHNOLOGY CENTER #3700

Sir:

This amendment is being submitted in response to the Official Action dated March 28, 2002.

Please amend the application by adding new claims 13 through 15 as set forth as Attachment C hereto and charge the fee therefore to deposit account 50-1943. Please further amend the application by modifying claims 3 and 4 as set forth in Attachment B hereto.

Applicant again requests reconsideration of the restriction requirement and notes that, contrary to the examiner's position as stated in the official action, claims 3-12 are not drawn to apparatus which "can be used as a work holder for any object." These claims are specifically directed to "an apparatus for removing a head of a golf club from

a shaft of a golf club" and certainly are not directed to apparatus which can be used as a work holder for any object under the sun. Applicant respectfully submits that when the claims are considered alone, and even more so when considered in view of the specification, it is manifestly clear that these claims are directed to an invention for removing a golf club head from a golf club shaft and that there would be no other reasonably utility for the invention defined by the claims previously in the application.

The same is true for the claims that had been newly added to the application.

Accordingly, applicant again requests that the restriction requirement be reconsidered and withdrawn. Applicant respectfully submits that the method and apparatus aspects of the invention do not qualify as being "distinct" and that the alleged different classification of the method and apparatus claims for the invention are strictly a matter of administrative convenience for the Patent and Trademark Office, having nothing to do with the burden associated with the searching required to evaluate the novelty of the claims whether they be method or apparatus.

Specifically, as applicant has noted previously and again asserts, any adequate search of the prior art respecting the novelty and patentability of this invention must necessarily cover the art necessarily embraced by class 273, subclass 80.3 which is directed to methods for removing the head of a golf club from the shaft of the golf club, as well as class 269, subclass 909 which is the class and subclass for apparatus for removing the head of a golf club from a golf club shaft. Applicant again requests reconsideration and withdraw of the restriction requirement in light of the clear limitation of the claims of this application as being directed to apparatus and methods for removal of golf club heads from golf club shafts.

Claims 3-12 had previously been pending in this application. Claims 5 and 8 have been deemed allowable by the Examiner in the Official Action dated March 28, 2002. Applicant has amended claim 3 to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claims 3 and 4 to better define the scope of the claims. No new matter is introduced by the amended claims.

Applicant has attached a clean copy of the amended claims (Attachment A) and a marked copy of the amended claims (Attachment B). The newly added claims are set forth in Attachment C. For the convenience of the Examiner, the applicant has attached a copy of all of the claims now pending in the application in their present form (Attachment D).

The Examiner's Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 3 and 4 as being indefinite and failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Applicant submits the golf club recited is not part of the invention but defines the intended use of the invention.

Applicant has amended claim 3 as requested by the Examiner to recite a "hollow shaft" as in claim 4 so as to eliminate any ambiguousness regarding the shaft of the golf club and the hollow shaft of the device.

Applicant submits the rejection should be withdrawn.

The Examiner's Rejection of Claims 3, 9 and 10 Under 35 U.S.C. § 102

Claims 3, 9, and 10 are rejected based on 35 U.S.C. § 102, as being anticipated by U.S. Patent No. 4,910,849 ('849) to Marshall.

Applicant submits that the '849 patent does not anticipate the invention because '849 does not recite a spring residing within the hollow shaft as in claims 3 and 4. MPEP § 2131. This limitation is not a random choice but is part of the design of one of the apparatus aspects of the invention based on its function and objectives. In addition, the Examiner has stated, "Marshall, discussed in detail above, discloses the invention **except for having a spring residing within the hollow shaft.** "

Additionally, claims 9 and 10 cannot be anticipated by the '849 patent due to the absence of the limitation regarding the hollow shaft.

Applicant submits the rejection should be withdrawn.

The Examiner's Rejection of Claims 4, 6-7, 11 and 12 Under 35 U.S.C. § 103(a)

Claims 4, 6-7, 11 and 12 are rejected based on 35 U.S.C. § 103(a), as being unpatentable over U.S. patent 4,910,849 ('849) to "Marshall in view of being of routine skill in the art."

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the one or more cited reference(s) or to combine the teaching of two or more references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references) must teach or suggest all the claim limitations. MPEP § 2143.

In this application, the Examiner's reasons given to support the proposed combination are improper in that the '849 patent is a single reference and hence does not contain or suggest any motivation to combine with any other reference, present no reasonable expectation of success and does not teach all of the recited claim limitations.

I. Motivation to Combine the Recited References

The '849 patent discloses apparatus wherein a golf shaft is placed within a tube surrounded by a spring device for removal of the head. Force is applied manually by compressing the spring by rotation of a nut. This design does not in any way suggest the claims of the apparatus aspect of this invention. The Examiner has apparently substituted "routine skill in the art" for a second reference to bridge the gap between the '849 patent and this invention. Applicant respectfully submits no motivation or suggestion exists for one of ordinary skill in the art to use the cited art to obtain the invention. Specifically, the design of the "force production", in relation to the golf club, in no way suggests this invention.

As declared by the Federal Circuit:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Structurally, the device of the '849 patent is in no way similar to the apparatus aspect of this invention. Specifically, the cited art has a nut to be tightened manually. Moreover, it would be impossible to operate the device of the '849 patent if the nut were

within the shaft of this invention. Further, the Examiner equates the one piece hollow shaft recited in claim 4 with the plurality of pieces (45, 26 and 32) which define the shaft shown in the '849 patent. Thus, the elements do not have the same structure or function as the hollow shaft of this invention. The Examiner has clearly engaged in improper hindsight reasoning to try to find some support for the rejection.

The Federal Circuit has also stated:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Further, in regard to the claim 4 hollow shaft, the Examiner has stated that rearranging of parts of an invention involves only routine skill in the art and bases his support on In re Japikse, 86 USPQ 70. In Japikse, the rearrangement of a known combination of elements for a hydraulic press was found to be an obvious modification.

Applicant respectfully submits the Examiner has misinterpreted Japikse, and does not appreciate the device of this invention as a whole. In Japikse, the device was a hydraulic powered press wherein the rearranging of the position of the switch alone was the basis for the Court's decision. However, here the entire apparatus of the '849 patent must be "rearranged" in order to even arguable arrive at this invention. Further, individual elements must be redesigned to be equivalent to the elements in the '849 patent, i.e., the hollow shaft. As stated in Japikse, "there would be no invention in shifting the starting switch disclosed by [prior art] to a different position **since th**

operation of the device would not thereby be modified.” Japiske, at 73 (emphasis added). In contrast, the device of the ‘849 patent would need to be completely modified to operate in the manner of the present invention. Thus, the Examiner’s reliance on Japikse is misplaced.

Further, it is well settled that if a proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is not a suggestion or motivation to make the proposed modification. MPEP § 2143.01. Excluding the “nut” would make the device of the ‘849 patent completely inoperable. There is no suggestion or motivation to eliminate the “nut” design entirely which the Examiner can expound, or to direct a person of skill in the art to arrive at the present invention.

Finally, the applicant appreciates the disclosure in Col. 2 lines 36 to 42 of the ‘849 patent wherein the biasing means can be manual, pneumatic or hydraulic or other form. Applicant submits that this disclosure in no way describes the modifications which would be necessary to transform the ‘849 patent into the present invention.

Based on the above arguments, there is no “suggestion”, or “objective teaching” which must be evident before the legally requisite “prima facie case of obviousness” can be established. There is no teaching nor suggestion in the ‘849 reference, that would lead one to the claimed invention. The unique structure of the present invention is clearly an advance over the prior art. Combining the ‘849 patent with a “boundless” concept of one skilled in the art is legally unjustified and is therefore inappropriate because the claimed invention cannot be easily reached from one or a combination of prior art citations.

II. Reasonable Expectation of Success

Based on the above argument, there is no expectation of success to combine the reference with the "skill in the art" to obtain the claimed invention.

III. The Combination of References Fail to Teach Every Element of the Claimed Invention

There is no suggestion in the reference cited which teaches a structure containing all of the limitations of the present invention. Applicant submits the recited references do not teach a device wherein the spring is within the hollow tube or the hollow shaft is of one piece construction.

Applicant respectfully submits the rejection of claim 4 based on obviousness should be withdrawn. Applicant further submits the rejections of claims 6,7,11 and 12 should be withdrawn as they depend from claim 4; a claim which depends from an allowable base claim should be allowed.

All the claims in this application are in condition for allowability as the present invention is clearly an advance over the prior art. Therefore, it is now believed by applicant the rejections have been overcome and it is now requested the application should thus proceed to allowance and issue.

If further questions remain concerning this application, the Examiner is invited to contact the undersigned attorney to resolve any remaining issues.

September 30, 2002

Respectfully submitted,



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